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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,895	03/28/2001	Keiichi Onodera	041514-5116	9524
9629	7590	10/14/2003	EXAMINER	
MORGAN LEWIS & BOCKIUS LLP			PHAM, HAI CHI	
1111 PENNSYLVANIA AVENUE NW			ART UNIT	
WASHINGTON, DC 20004			PAPER NUMBER	

2861

DATE MAILED: 10/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/817,895

Applicant(s)

ONODERA ET AL.

Examiner

Hai C Pham

Art Unit

2861

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 15-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-18, 21, 26, 31-37 and 42-51 is/are rejected.
- 7) ☒ Claim(s) 19, 20, 22-25, 27-30, 38-41 and 46 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 15-17, 26, 32-33, 48-50 are rejected under 35 U.S.C. 102(e) as being anticipated by Kobayashi et al. (U.S. 6,088,323).

Kobayashi et al. discloses an optical disk recording method and apparatus, which comprises a driving component (4) for driving the optical recording medium optical disk 50), and a writing component (laser 7) for forming a visible image pattern (Fig. 8) by irradiation of light (laser beam) on a recording layer formed in the optical recording medium to generate a change in optical characteristic of said recording layer where pits are formed with the light as compared to a pit-less portion where pits are not formed (the

low reflectance area [formed by pits] as compared to the high reflectance area [formed by lands]) (col. 2, lines 13-18 and col. 10, lines 13-32), wherein the optical recording medium is a recordable optical disk (write-once type optical disk) (col. 12, lines 36-43), which is readable by a disc player (CD player 42) (col. 12, lines 48-61).

Kobayashi et al. further discloses a data generating component (51), the writing component modulating the light based on image pattern data generated by said data generating component (via light modulator 52) and irradiating the modulating light on said recording layer (col. 10, lines 28-32), the writing component being commonly used for recording data of the visible image pattern and for recording of recordable data other than the data of the visible image pattern into the recording area of the optical recording medium, and the recording medium being a recordable optical disc, which is readable by a disc player (compact disk player 42).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 18, 21, 31, 34-37, 42-45, 47, 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. in view of Nomura et al. (U.S. 4,967,286).

Kobayashi et al. discloses all the basic limitations of the claimed invention except for the editing component, a display component, and the visible image pattern being recorded in an unrecorded area of the optical recording medium.

Nomula et al. discloses a method and apparatus for forming a digital image on a master optical recording medium, the apparatus comprising a driving component (mastering turntable 32) for driving the optical recording medium, and a writing component (laser 38) for forming a visible image pattern (18) by irradiation of light (laser beam) on a recording layer formed in the optical recording medium to generate a change in optical characteristic of said recording layer between a portion where pits are formed with the light and a pit-less portion where pits are not formed (the visible image 18 being formed by generating pits 26 on a background of pit-less reflecting surface 24, the pits creating visual effect, which contrasts markedly against the specular reflecting surface, e.g. difference in reflectance) (col. 3, lines 1-28). With regard to claim 47, Nomula et al. teaches a program for executing the image pattern writing for forming a visible image pattern on a recording layer of the medium through irradiation of the laser beam. Nomula et al. further teaches an editing component for editing the image pattern data (col. 5, lines 14-16 and 38-40) (Fig. 7), the editing component changing a size of the image pattern data (col. 6, lines 59-61), the writing component being commonly used for recording data of the visible image pattern and for recording of recordable data other than the data of the visible image pattern into the recording area of the optical recording medium (col. 3, lines 25-28), a display component (video monitor 46), the visible image pattern being constituted by any characters, signs (18, Fig. 1), the image pattern being recorded in an unrecorded area (image surface area 16) of the optical recording medium,

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the device of Kobayashi et al. with the aforementioned teachings of Nomura et al. The motivation for doing so would have been to allow the image pattern recorded on the optical recording medium to correlate with the recorded data.

***Allowable Subject Matter***

5. Claims 19, 20, 22-25, 27-30, 38-41, 46 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

6. Applicant's arguments filed 07/31/03 have been fully considered but they are not persuasive.

With regard to Applicants' arguments concerning Kobayashi et al. not teaching or suggesting a "change in optical characteristic of the recording layer where pits are formed as compared to a pit-less portion where pits are not formed", the examiner respectfully disagrees. Kobayashi et al. does teach the formation of the image pattern observable and confirmable with eyes by creating pits on the recording layer such that the reflectance of the optical disk is locally changed due to the low reflectance of the pits as compared to the high reflectance of the lands (non-pit area) (col. 2, lines 13-18 and col. 10, lines 13-32).

With regard to the teachings of Nomula et al., although the replica [audio compact] disks are formed by pressing operation from a master CD, the master process of the master CD includes an editing component for editing the image pattern to be recorded in an unrecorded area of the master CD, and wherein the master CD as well as the replica disks are destined to be played back on a disk player.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai C Pham whose telephone number is (703) 308-1281. The examiner can normally be reached on T-F (8:30-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Benjamin R. Fuller can be reached on (703) 308-0079. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722, (703) 308-7724, (703) 308-7382, (703) 305-3431, (703) 305-3432.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



HAI PHAM  
PRIMARY EXAMINER

October 8, 2003